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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
10 087,960	03 05 2002	Paul Jan Friday		5358

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Paul Jan Friday  
P.O. Box 850  
Coloma, MI 49038

[REDACTED] EXAMINER

HOAS, WENDY C

ART UNIT	PAPER NUMBER
1661	[REDACTED]

DATE MAILED: 10 01 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/087,960	Friday
	Examiner Wendy Couchoud Haas	Art Unit 1661



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1)  Responsive to communication(s) filed on 3/5/02.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

4)  Claim(s) 1 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 3/5/02 is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## DETAILED ACTION

### Title

The following title is suggested: "Peach Tree Named 'P.F. 28-007'".

### Objection to the Disclosure

### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

- (a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

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In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Applicant must include the botanical name beneath a separate heading in its own section at the beginning of the specification in order to comply with rule 1.163(c)(4). Correction is needed. An example of this would be an addition like the one below prior to Page 1, line 1 of the specification (but after the title):

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#### **BOTANICAL CLASSIFICATION**

*Prunus persica.* --

B. Applicant must describe the size and shape of the petals, the number of petals, sepals, anthers, stamens and pistils and provide color description for same with reference to the employed color chart.

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C. Applicant states that the instant plant originated as a selection from a seedling population.

The plant must originate as a single plant to qualify for statutory protection under 35 U.S.C. §

161. Correction and/or clarification is needed.

D. Applicant is requested to disclose whether the comparison cultivar 'Loring' has been patented in the United States, is currently the subject of a pending U.S. plant patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the cultivar name, or such could simply be acknowledged in applicant's next response.

E. Applicant should refer to cultivar names within single quotation marks, as this is the convention employed by the International Code of Botanical Nomenclature.

F. Page 4, "Panatone" is properly spelled -- Pantone--.

G. Applicant should set forth a more detailed botanical description relative to trunk size by providing the diameter of the trunk at a particular age at a specific height from the ground.

(Example: The trunk has a diameter of 65 cm when measures 12" from the ground at 3 years of age.) Applicant should also provide a color designation for the trunk with reference to the employed color chart, if available.

H. If possible, applicant should set forth a more detailed botanical description relative to branch size and typical crotch angles of same. Applicant should also provide a color designation for the branches with reference to the employed color chart, if available.

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- I. Applicant's description of the leaves of the instant plant is insufficient. First, it is unclear what applicant means by "*Texture*. -- Medium." Medium is not a texture. Second, applicant should positively quantify the typical and observed petiole length of the leaves. Third, applicant must provide the gland shape and color, at least in general terms. Additional information is needed.
- J. Applicant should positively quantify the bud size, and set forth the bud shape (i.e. ovoid, etc.) as well as provide the color of the bud with reference to the employed color chart.
- K. Applicant should import into the specification information regarding the specific botanical features of the flower such as characteristic and observed number of flowers per cluster, color with reference to the employed color chart, and characteristic fragrance (if any).
- L. The claim on page 7-8 must be deleted and replaced by the claim (already filed) on a separate sheet. Applicant must specifically cancel the first claim, even though the second claim has been received. Applicant must also amend the claim to be in a proper form. The claim must be a single sentence. Appropriate correction is required.
- M. Characteristic and observed fruit weight should be imported into the specification.
- N. Applicant should provide the age of the plant as described in the Description of Variety.
- O. Applicant must provide an additional photograph that clearly shows the leaves of the plant.
- P. Applicant must describe the kernel of the stone.

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The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

**Claim Rejection**

**35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

**Comments**

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute

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the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

**Applicant's Response**

It is called to applicant's attention that if a communication is deposited with the U.S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Assistant Commissioner for Patents

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Washington, D.C. 20231

on \_\_\_\_\_ (date).

Typed or printed name of person signing this certificate

---

Signature \_\_\_\_\_

Date \_\_\_\_\_

**Drawing Changes**

Applicant is advised of the changes to 37 CFR 1.84 which took effect November 29, 2000. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on bristol board, paper or other material.

Further information on the new rules is available on the USPTO web site at [www.uspto.gov](http://www.uspto.gov).

In addition, should applicant choose to send new photographs, the photographs should be mailed to:

USPTO  
P.O. BOX 2327

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Arlington, VA 22202

or hand-carried or delivered via Federal Express or UPS to the Examiner's attention at:

Crystal Mall One  
7th Floor Reception Area  
1911 South Clark Street  
Arlington, VA 22202

The mail arriving at the normal USPTO address is currently irradiated. This treatment destroys the photographs. Therefore, if applicant chooses to send new photographs, they should be sent via the above means. The examiner apologizes for any inconvenience.

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (703) 308-8898. The Examiner can normally be reached Monday through Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3041 or 308-4242. The Examiner's fax number is (703) 746-3166.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

W. C. Haas

*Bruce Campell*  
BRUCE R. CAMPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
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